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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,277	10/28/2003	Yong Ho Son	SEDN/152CON2	3963

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EXAMINER	
SAINT CYR, JEAN D	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
02/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,277	SON ET AL.	
	Examiner	Art Unit	
	Jean D. Saintcyr	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. **Response to Amendment**

This action is in response to applicant's amendment filed on 12/03/2007.

Claims 1-11 are still pending in the present application. **This action is made FINAL.**

Response to Arguments

Applicant's arguments filed on 12/03/2007 have been totally considered, but they are not persuasive. Applicant said that there was examiner's suggestion to file a terminal disclaimer to overcome the non-statutory obviousness double patenting rejection. However, the examiner did not suggest anything to the applicant in order to overcome double patenting rejection. As mentioned in the first office action, claims 1-9 of the current are similar to claims 1-9 of the US. Patent 6681326. The difference between these two sets is not significant. In the current application, the applicant only added remote server just to show that the claims of the current application are different from the claims of the US. Patent 6681326. In order to store, process and cause transmission, we need to have a storage unit located somewhere in the system. By just adding"remote server" to the claims of the current application did not make them different from the previous claims of US. Patent 6681326.

Applicant argues that Heer et al (US. Pat.5999629) have only one storage unit and are capable of anticipating the examined application. However, Heer et al disclose in fig.1, element 10, a video program generator that has all the functions of a normal VCR, including storing data. The memory 26 of fig.1, can be used to store data because Heer et al disclose that memory 26 may be the elements of a personal computer or workstation, e.g., an IBM compatible PC system. This information proves that the system of Heer et al had more than one storage units.

Finally, applicant argues that Heer et al did not disclose partially and fully encrypted program. However, Heer et al disclose that the partially encryption is done by the element 20 of fig.1, information protection system and the fully encryption is completed by element 40, access control system. Both elements, 20, 40, have their own memory to store data. As a result, applicant's arguments are not persuasive.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of US. Patent No. 6681326. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-9 are obvious variants and encompassed by claims 1-9 of the US. Patent 6681326. However, In order to store, process and cause transmission, we need to have a storage unit located somewhere in the system and that proves that any server that is located inside or remotely from the distribution system is not new to the system. So, adding remote server to the claims of the current

application did not make different from the claims of the US. Patent 6681326. As, a result, applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Heer et al, US Patent No.5999629 .

Re claim 1, Heer et al disclose at least one programming source for storing at least one partially encrypted video program(fig.1, element 26, memory; supplies the result of each such encryption and the associated serial number to processor 25 for storage in memory 26); a distribution center comprising a remote server(fig.1, element 60, video server), said remote server storing said at least one partially encrypted video program received from said at least one programming source(see fig.1, element 10, video program generator), and said remote server processing (fig.1, element 45, processor)said partially encrypted video program corresponding to a subscriber requested video program to produce a fully encrypted video program(When head-end security module 30 has completed encrypting such information, it then supplies the result to processor 25. (Hereinafter head-end security module will also be referred to as just "security module 30.) Processor 25, in turn, supplies the encrypted information to video server 60 for storage thereat in association with a unique serial number that

security module 30 previously generated and associated with the unique program encryption key, col.2, lines 52-60); and a subscriber-side distribution network coupled to the distribution center(see fig.1, distribution network coupled to the subscriber), for causing transmission of the fully encrypted video program to the requesting subscriber(responsive to receipt of the request, reformats the message and supplies it to video server 60 via path 42, col.7, lines 1-2).

Re claim 2, Heer et al disclose wherein said remote server causes transmission of a decryption key to said requesting subscriber via said subscriber-side distribution network, said decryption key being necessary to decrypt said fully encrypted video program(a user who has entered a request to review a program and would need the program key to decrypt the program for intelligible viewing, col.4,lines 23-26).

Re claim 3, Heer et al disclose wherein said fully encrypted video program is encrypted according to a public key associated (an associated public key, col.1, line 52) with said requesting subscriber, said public key having associated with it a private key(private key, col.4, line 34) necessary to decrypt said fully encrypted video program(to decrypt the encrypted program, col.4,line 7).

Re claim 4 ,Heer et al teach wherein said fully encrypted video program is encrypted according to a private key associated(private key, col.4, line 34) with said requesting subscriber, said private key having associated with it a public key (an associated public key, col.1, line 52) necessary to decrypt said fully encrypted video program(to decrypt the encrypted program, col.4, line 7).

Re claim 5, Heer et al teach wherein said fully encrypted video program is encrypted according to a public key(an associated public key, col.1, line 52), said public key having associated with it a private key necessary to decrypt said fully encrypted video program(to decrypt the encrypted program, col.4, line 7), said apparatus further comprising: said remote server(fig.1, video server) transmitting said private key to said requesting subscriber(distribute that key in a secure manner to user who has entered a request, col.4,lines 23-24).

Re claim 6, Heer et al disclose said public key(an associated public key, col.1, line 52) is encrypted prior to transmission to said requesting subscriber(encrypted and stored in server 60, col.2, line 63; that means public key was encrypted prior any transmission).

Re claim 7, Heer et al teach wherein said fully encrypted video program is transmitted to said requesting subscriber via a first communications channel and said decryption key is transmitted to said requesting subscriber via a second communications channel(see fig.1, the system uses bus 41 for encrypted video program and bus 61 for sharing key; col.6, lines 17-24; to this end, then, ACS 40 and module 30 communicate with one another via processor 25 and a communications channel of path 21 reserved for such communications to transport the "key" to ACS 40, col.4, lines 27-30; that means use a second path for channel communication) .

Re claim 8, Heer et al teach wherein said fully encrypted video program is encrypted according to a Data Encryption Standard (Digital Encryption System, col. 8, line 67).

Re claim 9, Heer et al disclose wherein said remote server multiplexes said fully encrypted video program and other signals to create a multiplexed signal (see fig.5, element 7, DES processor; input data handler 6 includes an input register file configured as a FIFO, register, byte counters and a multibit, e.g., 32 bit, multiplexer, col.9. lines 63-65) for transmission to said requesting subscriber(distribute that key in a secure manner to user who has entered a request, col.4,lines 23-24).

Re claim 11, Heer et al teach wherein said distribution center is coupled to said at least one programming source via a provider side distribution network(see fig.1, element 10, video program generator and element 60, video server).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heer et al in view of Garmeau et al, US Patent No. 5675647.

Re claim 10, Heer et al fail to teach wherein said at least one programming source comprises at least one of a television broadcasting source, a premium broadcast source, and a video- on-demand source.

In an analogous art, Garmeau et al teach wherein said at least one programming source comprises at least one of a television broadcasting source, a premium broadcast source, and a video- on-demand source(see fig.3 where a plurality of programming sources are connected to the Headend; pay per view or equivalent service, col.1, lines 51-52).

In view of the teaching of Garmeau, it would have been obvious for any person of ordinary skill in the art at that time the invention was made to implement wherein said at least one programming source comprises at least one of a television broadcasting source, a premium broadcast source, and a video- on-demand source into the system of Heer. With such extra option, Users will have more opportunities in selecting their service.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Duclos Saintcyr whose phone number is 571-270-3224. The examiner can normally reach on M-F 7:30-5:00 PM EST.If attempts to reach the examiner by telephone are not successful, his supervisor, Brian Pendleton, can be reach on 571-272-7527. The fax number for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see htpp://pair-direct.uspto.gov. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197(toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, dial 800-786-9199(IN USA OR CANADA) or 571-272-1000.

Jean Duclos Saintcyr
02/08/2008

Brian Pendleton
Supervisor Patent Examiner